

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: MAHLAB=2

In re Application of:) Art Unit: 2613
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Uri MAHLAB) Examiner: A. Bello
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Appln. No.: 09/936,440) Washington, D.C.
)
Filed: January 25, 2000) Confirmation No. 3860
)
For: METHOD AND APPARATUS)
 FOR ROUTING DATA-CARRYING)
 OPTICAL SIGNALS)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

Replying to the Office Action mailed October 27, 2009, and concurrent with the filing of the Notice of Appeal, please enter the following Pre-Appeal Brief Request for Review. Claims 45-55, 57, 59, 66-73, 82-84, and 86 were finally rejected on October 27, 2009. These claims have been rejected many times, without resolution.

Specifically, claims 45-47, 53, 55, 57, 66, 72, 82-83, and 86 were rejected under 35 U.S.C. § 102(b) as being anticipated by Barnsley (U.S. Patent No. 5,488,501). Claims 48-52, 54, 59, 67-71, 73, and 84 were rejected under 35 U.S.C. § 103 as being unpatentable over Barnsley in view of Nir (U.S. Patent No. 6,160,652). Applicant submits that the rejections should be withdrawn.

The Examiner has steadfastly maintained these rejections over many office actions. In response to the Office Action of January 28, 2009, Applicant filed the declaration of Dr. Uri Mahlab, the inventor in this case, and an expert with more than ordinary skill and experience (Mahlab, ¶¶1-4), which evidences how one of ordinary skill in the art would interpret the claims, and the cited art. The Final Action did not address the declaration, or explain why the evidence presented therein was being given no weight. For if it had been given weight, the Examiner would have had to allow the claims. Applicant respectfully submits that it was clear error to ignore the declaration evidence and for that reason alone, the Final Action should be withdrawn and the application passed to issue.

Turning to the merits of the rejections, each of the independent claims 45, 46 66, 82, and 86 recite, in different ways, that there are different optical fibers for carrying optical data signals separate from their associated optical addressing signals and optical fibers for carrying the optical addressing signals separate from their associated optical data signals between network elements and/or routers, and that the various claimed network elements and/or routers have routing capabilities.

In the April 27, 2009, response, citing to the Mahlab declaration, Applicant explained why Barnsley does not anticipate the independent claims, specifically because the path between 7 and 8 in Barnsley does not carry optical data signals separated from their associated optical addressing signals as recited in the independent claims. April 27, 2009, Response, page 17.

Applicant further explained that the points 4, 5, 6, 7, 8, 14 and 15 of Barnsley are not network elements as they would be understood by one of ordinary skill based on Applicant's disclosure, because one of ordinary skill in the art would

understand, based on the knowledge of the relevant technology, and from reading the specification, that a router, or a network element having routing capabilities, means a device having switching and forwarding capabilities. April 27, 2009, Response, pages 17-18. Applicant specifically explained why each of the points 4, 5, 6, 7, 14, and 15 and the light source and modulator in Barnsley, would not have been understood by one of ordinary skill in the art to have routing capabilities and thus would not be considered network elements with routing capabilities or routers, as required in the independent claims. April 27, 2009, Response, pages 18-19. The Final Action merely maintains the position that Applicant is incorrect (see "Response to Arguments", Final Action, page 13), without providing any evidence to contradict the evidence provided in the Mahlab declaration. This is improper. If the Examiner has no evidence to contradict the evidence of record, he should withdraw the rejection.

During the interview in December 2007, the Examiner explained his position that the claimed "first communication path" extends between optical data generator 4, and coupler 6, and the "second communication path" extends between control filter 14 and switch 8. Then, according to the Examiner, the line between data generator 4 (allegedly a network element) and between coupler 6 carries only data signals, so that meets the claimed "a first communication path . . . comprising at least one optical link (line 4-6) for carrying optical data signals separated from optical addressing signals". Further, the Examiner explained that in his opinion, the line between control filter 14 and switch 8 carries only addressing signals, so that meets the claims "a second communication path . . . comprising one

or more optical links for carrying optical addressing signals separated from said optical data signals."

Claim 45 was amended to distinguish the claimed invention over this interpretation. April 27, 2009, response, pages 19-20. One of ordinary skill in the art would understand that there is no suggestion in Barnsley how to carry optical data signals separated from their associated addressing signals between such at least two network elements of the telecommunication system, where each of the at least two network elements have routing, *i.e.*, switching and forwarding, capabilities. Mahlab, ¶ 30. Thus, Barnsley does not teach Applicant's claimed invention arranged as recited in claim 45. April 25, 2009, Response, pages 19-21, and Mahlab, ¶ 31. The Final Action does not address this argument or evidence.

Furthermore, Applicant argued, and provided evidence that establishes that one of ordinary skill in the art would understand from the disclosure of Barnsley that the both data and control signals must arrive together to the next node, and that the operation of the whole Barnsley system relies on and is based upon the fact that both data and control signals arrive together. April 27, 2009, Response, pages 21-22.

In other words, for the Barnsley system to route a packet, the packet must contain the addressing signal. Therefore, if at all, Barnsley must be considered as teaching away from the present invention. Because unlike Barnsley, which needs to have both the addressing signals and the data arriving at the network element together in order to ensure that the network element has the control signal required to send the data to the next network element, the present invention is designed so that the control signals and the data travel at least part of their respective paths,

separately. There is no explicit indication, nor any implicit suggestion provided by Barnsley, to transmit the data and control signals along different paths between two nodes or routers in the system, because Barnsley does not do so, and in fact, teaches away from doing so. *Id.*

The Examiner did not address this argument, or the evidence provided in support thereof. This is clear error, just in the failure to respond to the argument. Moreover, Applicant respectfully submits that in the face of the evidence of record, which has not been contradicted by any evidence provided by the Office, the rejection of independent claims 45, 46, 66, 82, and 86 should be withdrawn.

With respect to the rejection of 48-52, 54, 59, 67-71, 73, and 84, Applicant believes that these claims are patentable as well, and specifically reserves the right to address the particulars of this rejection in the Appeal, should one be necessary after this paper. However, for the sake of brevity, the specifics will not be discussed here.

For the reasons set forth above, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections of record. Applicant submits that the application is in condition for allowance. Early notice to this effect is most earnestly solicited.

Respectfully submitted,

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